

**Remarks**

Entry of the foregoing, reexamination and reconsideration of the subject matter of the invention as claimed herein are respectfully requested.

Claims 26 and 35 have been amended to make more clear that the aggregate is embedded in the PVC layer of the floor covering material and is exposed at the upper surface of the barrier layer. One skilled in the art would recognize from the originally presented claims that the aggregate must be embedded in the PVC layer of the material and must be "exposed" at the upper surface of the barrier layer – otherwise it would not be "exposed." This amendment thus does not change the scope of the claims.

For the reasons set forth below, it is respectfully submitted that the requirement for restriction and the rejections set forth the Official Action dated November 2, 2004, are in error. Accordingly, it is requested that the restriction and rejections be withdrawn and that a Notice of Allowability be issued. It is further noted that proper Patent Office Procedure was not followed in mailing the outstanding Official Action since it was not reviewed and signed by the TC Director. *See*, MPEP §2307.02. It is respectfully requested that this procedure be followed, if necessary, for any subsequent correspondence.

**Relevant Facts**

The instant application was filed November 6, 2002. It is a National Phase application filed pursuant to 35 U.S.C. §371 for PCT/GB99/03169, filed on October 11, 1999. Priority is claimed back to GB 9822019.7, filed on October 8, 1998. An Amendment was filed on October 15, 2003, to copy certain claims of U.S. Patent No. 6,579,610 ("the '610 Patent"). *See*, page 1 of the Amendment. The '610 Patent issued

from Application No. 09/830,041, which was a National Phase application pursuant to §371 for PCT/GB00/00056, filed on January 11, 2000, and claiming priority to GB 9900577.9, filed on January 13, 1999. The instant application thus has an earlier priority date than the '610 Patent.

The '610 Patent recited claims copied from the corresponding PCT application for the instant application. *See*, Preliminary Amendment dated April 20, 2001, page 10; and Amendment dated November 7, 2002, page 7. Applicants for the '610 Patent requested that an interference be declared with any pending U.S. application relating to PCT/GB99/03169, *i.e.*, the instant application. No such interference was declared, and nor is there any indication in the prosecution history that the instant application or the issue of priority of invention was considered.

In the Official Action dated November 2, 2004 for the present application, the previously issued Restriction Requirement was made final (page 2). In addition, the claims were rejected under 35 U.S.C. §112 as well as under 35 U.S.C. §102 (pages 2-5) over several references. All grounds for rejection should likewise apply to claims of the '610 Patent.

Regarding the §112 rejection, the phrases which were objected to by the Examiner ("in the material" and "exposed at the surface of the barrier layer" in claim 26) also appear in claim 31 of the '610 Patent.

Regarding the §102 rejections, the cited art (Sachs et al., U.S. Patent No. 4,196,243; Williams, U.S. Patent No. 5,433,979; and Plusquellec et al., U.S. Patent No. 5,965,198) are all prior art to the '610 Patent. In fact, the instant application has an earlier priority date than the '610 Patent. Thus, the rejections made in the instant application apply equally

to the '610 Patent. It is noted that Plusquellec et al. was cited and overcome during prosecution of the '610 Patent. Neither Sachs et al. nor Williams was cited during prosecution of the '610 Patent.

The Outstanding Official Action Was Improperly Issued

According to MPEP §2307.02: "If the ground of rejection is also applicable to the corresponding claims in the patent, any letter including the rejection must have the approval of the TC Director." In the instant application, the November 2, 2004, Official Action was signed by only the Examiner and SPE. See, page 6. The TC Director did not sign the Official Action. This was improper.

As described above, the claims pending in the instant application were all copied from the '610 Patent. Thus, the language objected to as indefinite also appears in the '610 Patent claims. Since the instant application is entitled to an earlier priority date, the prior art rejections made against the instant claims would also apply to the claims of the '610 Patent. Should any of the outstanding grounds for rejection be maintained, and/or should any new grounds for rejection that would apply equally to the '610 Patent be made, any subsequent Official Action must be reviewed and signed by the TC Group Director.

In addition, it is respectfully requested that the propriety of the Restriction Requirement be reviewed and reconsidered by the TC Director since identical claims appear restricted in the '610 Patent. Whether the product and process claims are directed to independent inventions could thus have implications for the '610 Patent claims. This is particularly true since the justification for the restriction was allegedly

that Plusquellec et al. anticipated or rendered obvious claim 26, and claim 26 is identical to claim 31 of the '610 Patent.

#### Restriction Requirement

It is respectfully requested that the Restriction Requirement be reconsidered and withdrawn. During prosecution of both the instant application and the '610 Patent, an interference was requested and in the instant application is appropriate based upon the copied claims. During prosecution of the '610 Patent, no restriction requirement was made. However, in the instant application, the same claims were restricted into two groups of inventions, the first directed to the floor covering material, and the second directed to a method of producing the claimed floor covering material. The basis for the restriction is that "the special technical features linking the two inventions, a floor covering with a PVC material, does not provide a contribution over the prior art, and no single general inventive concept exists." *See*, Restriction Requirement dated March 23, 2004, page 2. U.S. Patent No. 5,965,198 ("Plusquellec et al.") is cited as rendering claim 26 (previously identified as claim 31) anticipated or obvious, despite the fact that a similar rejection was overcome in the '610 patent.

During the prosecution of the '610 Patent, the claims were rejected as obvious over Plusquellec et al. alone as well as in combination with an additional reference. *See*, *Official Action* dated May 8, 2002. That Plusquellec et al. fails to disclose or even suggest the claimed invention was argued in the Amendment dated November 7, 2002, filed by applicants for the '610 Patent. The rejections were withdrawn and the claims were subsequently allowed. *See*, Notice of Allowability dated February 4, 2003.

Since the instant claims were copied from the '610 Patent and the claims of the '610 Patent were specifically allowed over Plusquellec et al., the cited reference does not anticipate or render obvious any of the instant claims. Additional reasons why Plusquellec et al. does not disclose or suggest the claimed invention are set forth herein, *infra*. The restriction of the instant claims in view of anticipation by Plusquellec et al. is thus improper and should be reconsidered and withdrawn.

Furthermore, applicants respectfully submit that the claims should not be restricted in order to facilitate declaration of an interference. Under MPEP §2303.01, *all* common subject matter between two applications, or similarly between an issued patent and pending application, should be considered in declaring an interference. As stated *supra*, the '610 Patent includes claims directed to both a floor covering material (Group I) and a method of producing the claimed floor covering material (Group II). Thus, in an interference, priority for both the Group I and Group II inventions must be considered. To simplify declaration of an interference, all of the copied claims in the instant application should be kept together in one case. The floor covering material and method of producing the floor covering material should all be in one interference; however, if deemed appropriate, the claims could be designated as corresponding to separate Counts.

If the claims are restricted, declaration of an interference could be greatly delayed. The non-elected Group II claims would have to be presented in a divisional application and allowable claims found before an interference could be declared. To ensure the just and speedy declaration of an interference and resolution of allowable claims, as well as decrease pendency of the instant application, the restriction requirement should be withdrawn.

Moreover, restriction is only proper if there is a serious burden on the Examiner to examine both groups of inventions. MPEP §803. In the instant case, there would be no serious burden for the Examiner to examine claims directed to a floor covering material as well as claims directed to a method for making such floor covering material, as it is just that claimed method which is used to produce the claimed floor covering material.

#### Rejection under §112

Claim 26 has been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed. Applicants note that the same language which is being objected to in applicants' claim 26 also appears in claim 31 of the '610 Patent. This rejection, if proper, would thus apply to the '610 Patent as well.

When judging whether a claim is indefinite, the claim must be read in light of the specification and the clarity judged from the perspective of a person skilled in the art. *Beachcombers, International, Inc. v. WildeWood Creative Products, Inc.*, 31 F.3d 1154, 31 USPQ2d 1653 (Fed. Cir. 1994).

The phrase "in the material" in claim 26 was objected to as allegedly being unclear. More specifically, the Office Action asserts that it is unclear whether the aggregate is embedded in the polyvinyl chloride layer or the barrier layer of the polymeric material. One skilled in the art would clearly recognize that "the material" refers back to the "floor covering material" recited earlier in the preamble of the claim. Thus, it is clear that the aggregate is embedded in the floor covering material. It is further clear that the "floor covering material" is being referenced based upon the later recitation of "the material" as incorporating "a barrier layer of polymeric material other

than PVC fused into the upper surface of the PVC layer.” In the context of the claim, it is sufficiently clear that “the material” is the “floor covering material,” as recited in the preamble. As amended, the claim makes even more clear that the aggregate is embedded in the PVC layer of the floor covering material.

In addition, the phrase “exposed at the surface of the barrier layer” in claim 26 was said in the rejection to be allegedly unclear. Contrary to the assertion in the Official Action, it is respectfully asserted that a person skilled in the art would know on which surface of the barrier layer the aggregate is exposed. One skilled in the art would clearly recognize that the aggregate is exposed at the upper surface of the barrier layer. Such aggregate could only be “exposed” on the upper surface since the lower surface is fused to the PVC layer thereby covering the aggregate. *See*, page 3, third paragraph. In addition, the purpose of the embedded aggregate is “for providing surface roughness.” This can only be achieved by having the aggregate at the upper surface. Moreover, Figure 1 shows that the aggregate is exposed at the upper surface of the barrier layer. *See also*, page 10, last paragraph, which describes Figure 1. In addition, the claims as amended make clear that the aggregate is exposed at the upper surface.

In view of the above, it is respectfully requested that the rejection of claim 26 under §112, second paragraph, be reconsidered and withdrawn. Such action is believed to be in order.

Sachs et al., USP 4,196,243<sup>1</sup>

Claims 26-29 and 32 have been rejected as allegedly anticipated by Sachs et al. under 35 U.S.C. §102(b). This rejection is respectfully traversed.

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<sup>1</sup> This reference is cited on the face of the Altro patent (USP 6,579,610)

The Official Action asserts:

Sachs et al. disclose a non-skid floor covering with a wear, barrier, layer fused over a polyvinyl chloride substrate (Column 1, lines 60-62 and 66). Since the two layers of materials are fused together, it is inherent that the barrier layer is at least as flexible as the underlying polyvinyl chloride layer. The wear layer is made with a thermoplastic material of a polyurethane material (Column 2, lines 36-37), which is cured through exposure to an ultra-violet light (Column 5, line 29). Incorporated in with the wear layer are no-skid plastic particles, aggregate, exposed to a surface to provide surface roughness (Column 7, lines 29-40).

This assertion is in error. Sachs et al. does not disclose a floor covering as claimed. Sachs et al. discloses a non-skid PVC floor covering having a wear layer over the vinyl substrate. The wear layer can be "any suitable material with conventional PVC organosol or plastisol wear layers and urethane wear layers being preferred." Column 2, lines 34-37. According to Sachs et al., particulate plastics material may be dispersed in the upper wear layer to provide an uneven surface for the wear layer. *See*, column 1, lines 32-34; column 3, lines 9-13. At the very least, Sachs et al. does not disclose or suggest including aggregate embedded in the lower PVC layer as opposed to the barrier or wear layer.

Nor does Sachs et al. disclose or suggest having aggregate embedded in a first PVC layer and "exposed at the upper surface of the barrier layer," as instantly claimed. Sachs et al. states that particulate plastics material may be included in wear layers (column 7, lines 41-45). However, this recitation does not teach or even suggest that aggregate can be embedded in the PVC layer, and that the aggregate should be exposed at the upper surface of the barrier layer, as instantly claimed.



Furthermore, Sachs et al. does not teach or suggest using aggregate to provide surface roughness to the floor covering material, as instantly claimed. The particles included in the Sachs et al. floor covering are "particulate plastics material." Such particles would not provide the surface roughness when exposed, as does the claimed aggregates. The difference between the particulate plastics material and the claimed aggregates is particularly evidence by looking at the preferred embodiments, as recited in claim 34, of quartz, corundum and/or silicon carbide.

Nor does Sachs et al. teach a barrier layer that specifically is *not* PVC. As stated in the instant specification (page 2), a floor covering with a PVC surface layer will stain easily. In contrast, while Sachs et al. teaches the use of urethane wear layers, PVC organosol and plastisol are also contemplated as wear layers. This disclosure does not teach or suggest that PVC should *not* be used as the barrier layer, as claimed by applicants.

Sachs et al., in fact, teaches away from the instantly claimed invention. In the background of the invention, Sachs et al. states: "While sheet vinyl flooring having particulate matter protruding from the surface thereof has been manufactured, the particles used have been so soft that they have not been effective in providing a non-skid surface." Column 1, lines 16-20. Sachs et al. thus teaches that you could not have aggregate embedded in the material and exposed at the surface, which aggregate would provide surface roughness, as required by applicants' claims. Thus, Sachs et al. neither anticipates nor renders obvious the claimed invention, since a teaching away is the antithesis of obviousness.

Accordingly, in view of the above argument, reconsideration and withdrawal of the rejection of the claims under §102(b) as anticipated by Sachs et al. are respectfully requested and believed to be in order.

Williams, USP 5,433,979<sup>2</sup>

Claims 26-34 have been rejected as allegedly being anticipated by Williams under 35 U.S.C. §102(b). This rejection is respectfully traversed.

The Official Action asserts:

Williams discloses a non-slip surface (Column 3, lines 1-2) comprising a polyvinyl chloride floor matting material (Column 3, lines 10-11) covered with a barrier material of polyurethane or polyester, which is used to provide a surface roughness on an exposed surface through an aggregate material of silicon carbide embedded in the surface (Column 4, 11-36). The barrier layer is a cured thermoplastic material (Column 4, lines 39-46) that is flexible as the underlying polyvinyl chloride layer (Column 3, lines 61-68) and is transparent (Column 5, lines 27-34). The barrier layer provides enhanced dirt release and stain resistance in comparison with the polyvinyl chloride layer (Column 2, lines 37-40) while being shaped, embossed, through deformation (Column 3, lines 22-25)

This assertion is in error. Williams discloses a polymer backing material that has mineral particles adhered to the surface of the backing by a radiation-curable adhesive. The minerals are to provide a non-slip surface. *See*, Column 2, line 67 – column 3, line 2. The backing material is then laminated or bonded to a PVC flooring material. The backer material is “selected from the group consisting of polyurethane, polyester, polystyrene, polypropylene and other synthetic or natural polymer materials,

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<sup>2</sup> This reference is not cited on the face of the Altro patent (USP 6,579,610)

preferably a polyvinyl chloride backer, which compliment several of the physical properties of that substrate." Column 4, lines 25-30.

Williams fails to disclose or suggest a flooring material where aggregate are embedded in the PVC layer of the material and are exposed at the upper surface of the barrier layer. According to Williams, a size coat is "applied over the distributed abrasive grit particles." Column 4, lines 47-53. The mineral particles are thus "imbedded therein" into the resin system. Column 4, lines 58-60. There is no teaching of having the particles embedded in one layer and exposed at the upper surface of the second barrier layer, as instantly claimed.

Nor does Williams teach that the polymeric material should be "other than PVC," as instantly claimed. PVC is one of the choices for the backing material, and is, in fact, a preferred choice.

Thus, as Williams fails to anticipate the claimed invention, reconsideration and withdrawal of the rejection of record are respectfully requested. Such action is believed to be in order.

**Plusquellec et al., USP 5,965,198<sup>3</sup>**

Claims 26, 28, 29 and 33 have been rejected as allegedly being anticipated by Plusquellec et al. ("Plusquellec et al.") under 35 U.S.C. §102(e). This rejection is respectfully traversed.

The Official Action asserts:

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<sup>3</sup> This reference is cited on the face of the Altro patent (USP 6,579,610)

Plusquellec et al. disclose a non-skid floor covering with a coating, barrier, layer fused over a polyvinyl chloride substrate (Column 4, lines 14-20). Since the two layers of materials are fused together, it is inherent that the barrier layer is at least as flexible as the underlying polyvinyl chloride layer. The coating layer is made with a thermoplastic material (Column 12, lines 33-36) where incorporated in with the coating layer are vinyl polymer plastic particles, aggregate, exposed to a surface to provide surface roughness (Column 6, lines 29-31).

Plusquellec et al. discloses a PVC substrate "in which the particles for incorporation form a single matrix with the thermoplastic base material in at least one surface layer of the coating layer, and the latter comprises practically no plastifying agent consisting of at least one volatile organic compound which has a vapor pressure of at least 0.1 Pa at 20°C." Column 4, lines 17-23. Plusquellec et al. further states that "the particles must form a homogeneous matrix which is integrated with the thermoplastic base material, if possible as soon as they are incorporated into the plastisol, and at least into a surface layer of the coating layer, and in any event after gelling. It follows that there is no sedimentation of the particles, nor encapsulation of the latter in the matrix of the coating layer." Column 4, lines 24-30.

Plusquellec et al. does not disclose or suggest a floor covering having aggregate embedded in the PVC layer of the floor covering material, where the aggregate are exposed at the upper surface of a barrier layer, as instantly claimed. Plusquellec et al. discloses a process whereby the particles are accelerated toward the external surface of the coating layer particles, but the particles remain "incorporated homogeneously in at least one, top or back, surface layer of said coating layer." See, claim 1.

Nor does Plusquellec et al. teach a floor covering having a barrier layer that is "other than PVC" fused into the upper surface of the PVC layer, as instantly claimed.

The coating layer in the cited reference appears to be a plastisol (*see*, column 6, lines 66-67), which can be PVC. *See*, column 6, lines 24-30.

The Examiner cites Claim 10 of Plusquellec et al., which appears at column 12, lines 33-36, as disclosing that “[t]he coating layer is made with a thermoplastic material.” However, it is respectfully submitted that this assertion is incorrect. The “thermoplastic material” being referred to in claim 10 is the material of which the particles are made (*see*, claim 1(c) and 1(d)). These particles are clearly different from the “aggregate” embedded in the material for providing surface roughness.” There is nothing in Plusquellec et al. teaching that the incorporated PVC particles would provide any surface roughness. The PVC particles would be quite different from the aggregate, which is instantly disclosed as preferably being “quartz, corundum and/or silicon carbide.” *See*, claim 34.

During prosecution of the ‘610 Patent, rejections of the corresponding claims under §103 in view of Plusquellec et al. were apparently withdrawn in view of the following arguments:

The materials of Claims 31 to 46 and 61 to 69 are also distinguished from the disclosure of Plusquellec. Plusquellec Patent discloses a material having a coating wherein the coating is formed of a plastisol, applied in the pasty state and then powdered with a plastic powder. Accordingly, Plusquellec reference does not disclose anything about the incorporation of particles to provide a non-slip roughening effect to enhance slip resistance as provided in claim 31 or the inclusion of aggregate to provide surface roughness as provided in claim 61. Plusquellec disclosure makes clear that the powdered plastic included in the coating layer becomes a part of the coating layer when the layer is cured.

Neither the Chen nor Plusquellec references disclose or suggest alone or in combination the method specified in claim 47, which provides for a base portion of a flooring material on which a powder having components of a coating portion is added. Thereafter particulate material is added and the base and components are heated to form a film. In the Chen reference, the coating layer is separately

applied to the finished base layer. In Plusquellec reference there is no addition of particulate material.

Amendment dated November 7, 2002, page 6.

In view of the arguments stated above, as well as the reasons that the instant claims were found patentable over Plusquellec et al. during prosecution of the '610 Patent, the rejection under §102 in view of Plusquellec et al. should be reconsidered and withdrawn. Such action is respectfully requested and believed to be in order.

### III. Conclusions

In view of the above, Applicants respectfully request that the Restriction Requirement and all outstanding rejections be withdrawn. A Notice of Allowance is respectfully requested and believed to be in order. Upon the finding of allowable subject matter, an interference should then be declared between the instant application and the '610 Patent.

No additional fees are believed to be due in connection with this correspondence. However, if any fees are due, please charge any payments due to our Deposit Account No. 08-0219.

The Examiner is invited to telephone the undersigned at the telephone number given below in order to expedite the prosecution of the Application.

Date: 4/5/05

Respectfully submitted,



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